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Paper 56

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

POLICE S. REDDY, SURESH K. TIKOO,
and LORNE A. BABIUK
Junior Party
(U.S. Patent No. 6,492,343),

FAXED

AUG 9 - 2006

**PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES**

v.

MICHAEL A. JOHNSON, JEFFREY M. HAMMOND,
RICHARD J. McCOY and MICHAEL G. SHEPPARD
Senior Party
(U.S. Application No. 09/485,512).

Patent Interference No. 105,358
(Technology Center 1600)(MPT)

JUDGMENT - Bd. R. 127(b)

Before: LANE, MEDLEY and TIERNEY, Administrative Patent Judges.

TIERNEY, Administrative Patent Judge.

- 1 As discussed in the Order to Show Cause (Paper No. 50), VectoGen Pty Ltd
- 2 ("VectoGen") is now the owner of the involved Reddy patent and the involved Johnson
- 3 application. The Order to Show Cause was issued as the United States Patent & Trademark
- 4 Office does not normally maintain interferences between commonly owned patents or

1 applications. Bd. R. 206. In response to the Order to Show Cause, VectoGen has filed a request
2 for adverse judgment against Junior Party Reddy as to Counts 1 and 2, the only counts in
3 interference. (Reddy Request for Adverse Judgment, Paper No. 54).

4 During the course of this interference, Reddy filed three substantive motions. Reddy
5 Motion 1 moves to attack Johnson's accorded priority benefit date. (Paper No. 29). Reddy
6 Motion 2 alleges that all of Johnson's involved claims are unpatentable under 35 U.S.C. § 112,
7 first paragraph for failing to provide a sufficient written description and/or failing to enable a
8 person skilled in the art to make and use the claimed subject matter. (Paper No. 30). Reddy
9 Motion 3 alleges that Johnson's involved claims are unpatentable under 35 U.S.C. § 112, second
10 paragraph as the claims are indefinite. Additionally, in response to Reddy Motions 2 and 3,
11 Johnson filed a responsive motion, Johnson Motion 2,¹ which requests that Johnson's claims be
12 amended in response to Reddy Motions 2 and 3. (Paper No. 55).

13 Counsel for VectoGen, i.e., representing both Reddy and Johnson, specifically requests
14 that Reddy's three motions and Johnson's Motion 2 be withdrawn from consideration. No
15 Johnson oppositions to the three Reddy motions have been received by the Board. Similarly, no
16 opposition to Johnson's responsive motion has been received by the Board. Thus, the issues
17 raised in Reddy and Johnson's pending motions are not fully developed.

18 Reddy Motion 1, which attacks Johnson's accorded benefit date, is *dismissed* as moot in
19 light of Reddy's request that adverse judgment be entered against Reddy. Further, based upon
20 the facts presented in this interference, including the fact that Johnson's involved claims are

¹While the motion is titled Johnson Responsive Motion 1, this is the second Johnson motion filed in the interference. Per the Standing Order (Paper No. 2), ¶ 121.1, each motion of a party is to be numbered consecutively. Thus, Johnson's responsive motion is referred to as "Johnson Motion 2."

1 present in a pending U.S. application, a determination as to the patentability of Johnson's claims
2 is best resolved by an examiner outside the course of this interference. Accordingly, we exercise
3 our discretion and recommend that the examiner of Johnson's involved U.S. Application No.
4 09/485,512 review the issues raised in Reddy Motions 2 and 3, and recommend that the examiner
5 enter any rejection deemed necessary. Bd. R. 127(c) and *In re Sullivan*, 362 F.3d 1324, 1327, 70
6 USPQ2d 1145, 1148 (Fed. Cir. 2004).

7 Johnson Motion 2 seeks to amend Johnson's involved claims in response to Reddy
8 Motions 2 and 3. As we do not reach the merits of Reddy Motions 2 and 3, Johnson Motion 2 is
9 *dismissed* as moot.²

10 It is:

11 **ORDERED** that judgment on priority of invention as to Counts 1 and 2, the only counts
12 in interference, is awarded against Junior Party Reddy.

13 **FURTHER ORDERED** that Junior Party Reddy is not entitled to a patent containing
14 claims 13-14, 16-19, 21-28, 30-40 and 43-44 of Reddy, U.S. Patent No. 6,492,343, all of which
15 correspond to Count 1.

16 **FURTHER ORDERED** that Junior Party Reddy is not entitled to a patent containing
17 claims 13-14, 16-19, 22-28, 31-40 and 43-44 of Reddy, U.S. Patent No. 6,492,343, all of which
18 correspond to Count 2.

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²Additionally, we note that Johnson Motion 2 does not identify where Johnson received authorization from the Board to file this particular responsive motion and a brief review of the record failed to reveal such authorization. As Johnson Motion 2 is dismissed as moot, we need not consider whether or not the filing of this particular motion was authorized by the Board.

1 **FURTHER ORDERED** that Reddy Motion 1 (Paper No. 29), attacking Johnson's
2 accorded priority benefit date, is *dismissed* as moot.

3 **RECOMMENDED** that the examiner of Johnson's involved application review Reddy
4 Motions 2 and 3 (Paper Nos. 30 and 31) and make any rejections deemed necessary to ensure the
5 patentability of Johnson's claims.

6 **FURTHER ORDERED** that Johnson Motion 2, which seeks to amend Johnson's claims
7 in response to Reddy Motions 2 and 3, is *dismissed* as moot.

8 **FURTHER ORDERED** that a copy of this paper shall be made of record in the files of
9 U.S. Application No. 09/485,512 and U.S. Patent No. 6,492,343.

10 **FURTHER ORDERED** that a copy of Reddy Motion 2, Reddy Motion 3 and Johnson
11 Motion 2 shall be made of record in the files of U.S. Application No. 09/485,512.

12 **FURTHER ORDERED** that the parties attention is directed to the settlement agreement
13 provisions in 35 U.S.C. § 135(c) and 37 C.F.R. § 41.205.

14
15 /Sally Gardner Lane/)
16 SALLY GARDNER LANE)
17 ADMINISTRATIVE PATENT JUDGE)

18))
19))
20 /Sally C. Medley/) BOARD OF PATENT
21 SALLY C. MEDLEY) APPEALS AND
22 ADMINISTRATIVE PATENT JUDGE) INTERFERENCES

23))
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TRIAL DIVISION
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